

27. (once amended) The process cheese base of claim 26, wherein the milk fat is cream, dried sweet cream, anhydrous milk fat, concentrated milk fat, or mixtures thereof.

28. (once amended) The process cheese base of claim 27, wherein the edible acid ranges from about 0.5 to about 2.0 percent.

A² 29. (once amended) The process cheese base of claim 28, wherein the edible acid is lactic acid.

30. (once amended) The process cheese base of claim 29, wherein the preservative ranges from about 0.15 to about 0.18 percent.

31. (once amended) The process cheese base of claim 30, wherein the preservative is sorbic acid.

32. (once amended) The process cheese base of claim 31, wherein the process cheese base has a fat content ranging from about 10 to about 40 percent.

REMARKS

Applicants respectfully request reconsideration of the above-identified application in view of the present Amendments and Remarks. Claims 1-34 remain pending.

The specification on page 6 has been amended to correct a typographical error (i.e., "fress cheese" was replaced with "fresh cheese").

Claims 20-32 are dependent claims, each of which depends, directly or indirectly, from product claim 19. The preambles of dependent claims 20-32 have been amended to be consistent with independent claim 19. No new matter has been added.

35 U.S.C. §102(a) Rejection

Claims 18-34 stand rejected under 35 U.S.C. §102(a) as being anticipated by Moran et al. (EP 0 997 073 A2). The Examiner asserts that "Moran et al. teach the preparation of fresh cheese from powdered milk," thus anticipating composition claims 18-34. The Examiner notes that claims 18-34 of the present application are product by process claims, and that the claimed products must be patentable independent of the process for producing them. This is the entire basis of the rejection offered by the Examiner. Moreover, the Examiner does not identify **any product or process** disclosed by Moran et al. that would anticipate or render obvious the compositions of claims 18-34.

Applicants respectfully submit that the present invention is neither anticipated nor rendered obvious by Moran et al. In order for a reference to anticipate a claim under 35 U.S.C. §102(a), the reference must teach **each and every element** of the claim. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP Section 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Moran et al. does not teach, or even suggest, each and every element of the claims in question.

Applicants further submit that the Examiner has not presented a proper 35 U.S.C. §102(a) rejection. The Examiner has not established that Moran teaches each and every element set forth in the claims in question. The Examiner states only the following:

Moran et al. teach the preparation of fresh cheese from powdered milk (see entire document).

Moran et al. teach a process for producing a cheese product directly from milk. The two-stage method taught by Moran et al. involves (1) forming a powdered milk protein concentrate, and (2) converting the powdered milk protein concentrate to the desired cheese product. While it may be possible to use the powdered milk protein concentrate produced in the first stage of the process taught by Moran et al.

as one of the starting materials recited in claims 18-34 of the present application, this does not support the conclusion that Moran et al. anticipates claims 18-34.

35 U.S.C. §103(a) Rejection

Claims 1-17 stand rejected under 35 U.S.C. §103(a) as being obvious over Moran et al. (EP 0 997 073 A2). The Examiner acknowledges that the claims of Moran et al. and the present claims differ in that the present claims recite a cooling step. The Examiner, however, asserts that it would have been obvious to one of ordinary skill in the art to cool the cooked product of Moran et al.

Applicants assert that whether or not cooling of the Moran et al. product would have been obvious (which it would not) is not relevant to the question of whether the present claims are obvious in view of Moran et al, as the two products are not the same. Nor does the Moran et al. product render the present claims obvious.

To establish a *prima facie* case of obviousness there must be some **suggestion or motivation** in the prior art to make the claimed invention, there must be a **reasonable expectation of success**, and the prior art reference **must teach or suggest all of the claim limitations**. MPEP 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991). **Both the suggestion and the expectation of success** must be founded in the prior art, and not in the Applicant's disclosure. *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988). The mere fact that the prior art can be modified does **not** make the modification obvious unless the prior art **taught or suggested** the desirability of the modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). The patent office has the burden of establishing a *prima facie* case of obviousness. MPEP 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Claims 1-17 are not rendered obvious by the teachings of Moran et al. Specifically, independent claims 1 and 4, are related to a method for making a cheese product or a process cheese base, respectively. Both of these claims and the claims which depend from them (claims 2, 3, and 4-17) require the following:

(a) mixing the following components:

- (i) one or more concentrated powders derived from milk, present in an amount ranging from about 25 to about 60 percent;
- (ii) sodium chloride, present in an amount ranging from about 0.5 to about 4.0 percent;
- (iii) milk fat, present in an amount ranging from about 9 to about 38 percent;
- (iv) water; and
- (v) optionally, an edible acid, present in an amount ranging from 0 to about 2.0 percent;
- (vi) optionally, a preservative, present in an amount ranging from 0 to about 0.2 percent; and

(b) cooling the mixed product for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product.

The second stage of the process disclosed by Moran et al. requires treating the milk protein mixture with shear and cooking the milk protein mixture. Neither one of these steps are recited in claims 1-17. Furthermore, Moran et al. do not teach or even suggest the production of a cheese product without the steps of treating the mixture with shear and subsequently cooking the mixture.

Moreover, it would **NOT** have been obvious to one of ordinary skill in the art to employ the cooling step required in the present invention "for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product" and **"wherein the cheese product has the texture and consistency of fresh cheese."** The Examiner did indicate that the "cooling of a product to room temperature is conventional and well within the skill of the art, where the solidification of the product is obvious due to the melting point of the product." This rationale, however, ignores the remainder of the limitation -- the cooling must be done for a time and at a temperature so as to form

the solid product wherein the solid product has the **"texture and consistency of fresh cheese."** It is the total combination of the process steps (including the cooling step) and composition limitations of claims 1 and 4 which allows the simplified production of a solid product having the **"texture and consistency of fresh cheese."**

The Examiner, other than merely stating her conclusion, has provided no basis or argument in Moran et al. or other prior art as to why one of ordinary skill in the art would cool "the mixed product for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product" and **"wherein the cheese product has the texture and consistency of fresh cheese."** The Examiner has not pointed out in the prior art of record how one of ordinary skill in the art would be lead to such a process or how one of ordinary skill in the art, assuming the prior art suggested such a cooling step (which it does no do), would expect such a cooling step, combined with the remainder of the claimed process, would result in "a solid matrix, wherein the solid matrix is the cheese product" and **"wherein the cheese product has the texture and consistency of fresh cheese."** Effectively, the Examiner is using hindsight reconstruction of the prior art using the Applicants own teachings to arrive at the rejection. As the Examiner knows, the use of such hindsight reconstruction is improper: "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W. L. Gore & Assoc., Inc. v. Oarlock, Inc.* 220 USPQ 303, 312-13. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). This prohibition against hindsight reconstruction was reaffirmed in *In re Dembicizak*, 50 USPQ.2d 1614 (Fed. Cir.1999):

"Measuring a claimed invention against the standard established by section 103 require the oft-difficult but critical step of casting the mind

back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" *In re Dembicizak*, 50 USPQ2d at 1617 (citations omitted).

Applicants respectfully submit that this rejection is improper and respectfully request that it be withdrawn.

CONCLUSION

Applicants respectfully assert that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are improper and should be withdrawn. Applicants respectfully request that the Examiner allow the pending claims and pass this Application to issue.

If the Examiner believes that a telephonic or personal interview would be helpful to terminate any issues which may remain in the prosecution of the Application, the Examiner is requested to telephone Applicants' attorney at the telephone number set forth herein below.

The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 06-1135.

Respectfully submitted

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